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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,297	09/26/2003	Ken R. Powell	104.005-04	6455
38245	7590	02/28/2006	EXAMINER	
JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)			SALIARD, SHANNON S	
211 N. UNION STREET, SUITE 100			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	
			3639	

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/670,297	POWELL, KEN R.	
	Examiner	Art Unit	
	Shannon S. Saliard	3639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 19 December 2005, with respect to the rejection(s) of claim(s) 1-7 under 35 U.S.C. 102 (b) and 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Palmer et al [U.S. Patent No. 6,505,773].

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 1, 3 and 5-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al [U.S. Patent No. 6,505,773].

As per **claim 1**, Palmer et al discloses a method of downloading a coupon for a product onto a smart card held by a user having access to a user computer that is in communication with a global computer network and a smart card reader/writer, the method comprising the steps of: (a) transmitting to the user computer, via the global computer network, data referring to the product [col 4, lines 9-13]; (b) receiving from the user computer, via the global computer network, data indicating that the user desires to

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receive a coupon for the product [col 5, lines 1-5] and (d) writing the coupon data onto the smart card with the smart card reader/writer [col 5, lines 13-16]. Palmer et al does not explicitly disclose (c) subsequently, transmitting to the user computer, via the global computer network, coupon data representative of the coupon after a request has been received. However, Palmer et al does disclose that coupon data is not written unto the smart card until product information is viewed in its entirety [col 5, lines 11-16].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Palmer et al to include transmitting coupon data after viewing product information and requesting a coupon associated with the product information. Palmer et al provides the motivation that the invention assures the advertisers that a consumer actually perceives the advertisement for a product before receiving coupons [col 2, lines 7-10].

As per **claim 3**, Palmer et al discloses a method of downloading a coupon for a product onto a smart card held by a user having access to a user computer that is in communication with a global computer network and a smart card reader/writer, the method comprising the steps of: (a) transmitting to the user computer, via the global computer network, data referring to the product [col 4, lines 9-13]; (b) receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 5, lines 1-5] and (d) writing the coupon data onto the smart card with the smart card reader/writer [col 5, lines 13-16]; (e) reading the coupon data with the second smart card reader/writer [col 5, lines 52-55]; (f) determining if a list of products, being purchased by the user, includes data

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corresponding to the coupon data [col 5, lines 57-59], and (g) if the list of products includes data corresponding to the coupon data, then reporting the coupon to a coupon clearinghouse via a telecommunications link [col 6, lines 22-32]. Palmer et al does not explicitly disclose (c) subsequently, transmitting to the user computer, via the global computer network, coupon data representative of the coupon after a request has been received. However, Palmer et al does disclose that coupon data is not written unto the smart card until product information is viewed in its entirety [col 5, lines 11-16].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Palmer et al to include transmitting coupon data after viewing product information and requesting a coupon associated with the product information. Palmer et al provides the motivation that the invention assures the advertisers that a consumer actually perceives the advertisement for a product before receiving coupons [col 2, lines 7-10].

4. **Claims 2 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al [U.S. Patent No. 6,505,773] in view of Thaxton et al [U.S. Patent No. 6,691,915].

As per **claim 2**, Palmer et al discloses a method of downloading a coupon for a product onto a smart card held by a user having access to a user computer that is in communication with a global computer network and a smart card reader/writer, the method comprising the steps of: (a) transmitting to the user computer, via the global computer network, data referring to the product [col 4, lines 9-13]; (b) receiving from the

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user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 5, lines 1-5] and (d) writing the coupon data onto the smart card with the smart card reader/writer [col 5, lines 13-16]; (e) reading the coupon data with the second smart card reader/writer [col 5, lines 52-55]; (f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data [col 5, lines 57-59]. Palmer et al does not explicitly disclose (c) subsequently, transmitting to the user computer, via the global computer network, coupon data representative of the coupon after a request has been received. However, Palmer et al does disclose that coupon data is not written unto the smart card until product information is viewed in its entirety [col 5, lines 11-16]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Palmer et al to include transmitting coupon data after viewing product information and requesting a coupon associated with the product information. Palmer et al provides the motivation that the invention assures the advertisers that a consumer actually perceives the advertisement for a product before receiving coupons [col 2, lines 7-10].

Palmer et al does not disclose (g) if the list of products includes data corresponding to the coupon data, then crediting the user with an amount indicated by the coupon data. However, Thaxton et al discloses an electronic coupon method in which the product sale price is reduced by an amount indicated in the coupon data [col 5, lines 62-64]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Palmer et al to include the method

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disclosed by Thaxton et al so that the customer is encouraged to use coupons for specified products.

As per **claim 4**, Palmer et al discloses a method of downloading a coupon for a product onto a smart card held by a user having access to a user computer that is in communication with a global computer network and a smart card reader/writer, the method comprising the steps of: (a) transmitting to the user computer, via the global computer network, data referring to the product [col 4, lines 9-13]; (b) receiving from the user computer, via the global computer network, data indicating that the user desires to receive a coupon for the product [col 5, lines 1-5] and (d) writing the coupon data onto the smart card with the smart card reader/writer [col 5, lines 13-16]; (e) reading the coupon data with the second smart card reader/writer [col 5, lines 52-55]; (f) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data [col 5, lines 57-59], and (g) if the list of products includes data corresponding to the coupon data, then reporting the coupon to a coupon clearinghouse via a telecommunications link [col 6, lines 22-32]. Palmer et al does not explicitly disclose (c) subsequently, transmitting to the user computer, via the global computer network, coupon data representative of the coupon after a request has been received. However, Palmer et al does disclose that coupon data is not written unto the smart card until product information is viewed in its entirety [col 5, lines 11-16].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Palmer et al to include transmitting coupon data after viewing product information and requesting a coupon associated with the product

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information. Palmer et al provides the motivation that the invention assures the advertisers that a consumer actually perceives the advertisement for a product before receiving coupons [col 2, lines 7-10].

Palmer et al does not disclose (g) if the list of products includes data corresponding to the coupon data, then crediting the user with an amount indicated by the coupon data. However, Thaxton et al discloses an electronic coupon method in which the product sale price is reduced by an amount indicated in the coupon data [col 5, lines 62-64]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Palmer et al to include the method disclosed by Thaxton et al so that the customer is encouraged to use coupons for specified products.

5. **Claims 5 and 6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaxton et al [U.S. Patent No. 6,691,915].

As per **claim 5**, Thaxton et al discloses a method of receiving and redeeming coupons, redeemable at a store, with a smart card with a computer in communication with a global computer network and a smart card reader/writer and having a monitor, comprising the steps of: (a) viewing a plurality of available downloadable coupons received via the computer network on the computer monitor; (b) generating an input to the computer indicating a selection of a selected coupon from the plurality of available downloadable coupons; (c) subsequently receiving, via the global computer network, data corresponding to the selected coupon, and causing the received data to be written

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to the smart card [col 4, lines 2-16]; and (d) presenting the smart card to a smart card reader/writer at the store while purchasing a product corresponding to the coupon, (e) whereby the store applies a credit specified by the coupon data to a purchase price of the product [col 4, lines 28-44]. Thaxton et al does not explicitly disclose that the communication network is a global computer network. However, Thaxton et al discloses that the electronic coupon system is made up of a network of in-store kiosks and remote kiosks [col 4, lines 10-14]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Thaxton et al to include the method of communicating through a global communication network so that the host computer can communicate with kiosks located anywhere to correlate the transaction data with the coupon data read from the smart card within a short period of time.

As per **claim 6**, Thaxton et al discloses an electronic coupon downloading apparatus, comprising: (a) a processor in communication with a computer network; (b) a smart card reader/writer circuit, in communication with the processor, capable of writing data to a smart card; and (c) a program that receives a user selection, sends the received selection through the computer network, subsequently receives, through the communication network, coupon data corresponding to the selection, and causes the processor to write coupon data that is received via the computer network onto a smart card via the smart card reader/writer circuit [col 4, lines 2-16]. Thaxton et al does not explicitly disclose that the communication network is a global computer network. However, Thaxton et al discloses that the electronic coupon system is made up of a

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network of in-store kiosks and remote kiosks [col 4, lines 10-14]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Thaxton et al to include the method of communicating through a global communication network to preserve the computer memory since each kiosk does not have to locally store information related to all available coupons.

6. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Thaxton et al [U.S. Patent No. 6,691,915] in view of Palmer et al [U.S. Patent No. 6,505,773].

As per **claim 7**, Thaxton et al discloses a system comprising: an electronic coupon downloading apparatus including: (a) a processor in communication with a computer network; (b) a first smart card reader/writer, in communication with the processor, capable of writing data to a smart card; and (c) a program that receives a user selection, sends the received selection through the computer network, subsequently receives, through the communication network, coupon data corresponding to the selection, and causes the processor to write coupon data that is received via the computer network onto a smart card via the first smart card reader/writer [col 4, lines 2-16]; and a checkout station, for reading the coupon data stored on the smart card held by a user, including: (a) a cash register; (b) a processor in communication with the cash register and with a telecommunications link; (c) a second smart card reader/writer in communication with the processor; and (d) a program that executes the steps of: (i) reading coupon data on the smart card with the second smart card reader/writer; (iii) if

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the list of products includes data corresponding to the coupon data, then crediting the user with a refund of an amount indicated by the coupon data [col 4, lines 28-44].

Thaxton et al does not explicitly disclose that the communication network is a global computer network. However, Thaxton et al discloses that the electronic coupon system is made up of a network of in-store kiosks and remote kiosks [col 4, lines 10-14]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Thaxton et al to include the method of communicating through a global communication network so that the host computer can communicate with kiosks located anywhere to correlate the transaction data with the coupon data read from the smart card within a short period of time.

Thaxton et al does not disclose (ii) determining if a list of products, being purchased by the user, includes data corresponding to the coupon data; and (iv) reporting the coupon to a coupon clearinghouse via the telecommunications link. However, Palmer et al discloses determining if a list of products, being purchased by the user, includes data corresponding to the coupon data [col 5, lines 57-59], and then reporting the coupon to a coupon clearinghouse via a telecommunications link [col 6, lines 22-32]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Thaxton et al to include the method disclosed by Palmer et al. Thaxton et al provides the motivation that reporting the coupon usage to the clearinghouse allows the merchant to be reimbursed for valid coupons [col 6, lines 29-31].

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Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon S. Saliard whose telephone number is 571-272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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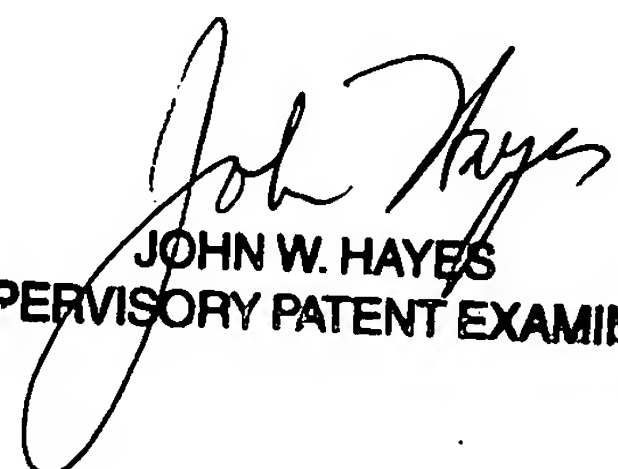
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Shannon S Saliard
Examiner
Art Unit 3639

SSS


**JOHN W. HAYES
SUPERVISORY PATENT EXAMINER**